

Remarks

Restriction to Inventions I, II, and III. The office action restricts the claims of the instant application into three groups: Group I (claims 1-5), Group II (claims 6-10) and Group II (claims 7-11), alleging that the inventions are distinct each from the other. Applicant respectfully traverses.

The inventions are distinct if (A) the inventions as claimed do not overlap in scope, i.e., are mutually exclusive; (B) the inventions as claimed are not obvious variants; and (C) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect. See MPEP § 806.05(j).

In the instant application, however, the inventions as claimed are not mutually exclusive. In particular, claims 1-5 are directed to a method of treating a subject in need of modulating the activity of aldose reductase; claims 6-10 are directed to a method of treating a neoplasm; and claims 11-13 are directed to a method of modulating the activity of aldose reductase in a cell. The inventions as claimed overlap with each other, as aldose reductase plays a role in carcinogenesis and overexpression of aldose reductase makes cells more resistant to cancer chemotherapeutic drugs (See Para. 0006 of the instant application).

Accordingly, Applicant requests that the restriction be reconsidered and withdrawn. However, to expedite the prosecution of the instant application, Applicant provisionally elects the claims of Group II.

Election of Species. The office action further requires that, upon election of the claims of Group II, election of one species from the each of the following genus be made: A) a single species of neoplasm; B) a single species of fibrate; and C) a single species of chemotherapeutic agent. Applicant respectfully traverses.

A requirement for restriction is permissible if there is a patentable difference between the species as claimed and there would be a serious burden on the examiner if restriction is not required. See MPEP § 808.01(a). With respect with neoplasm, the species cited in the Markush group of claim 9 are encompassed in the term "neoplasm" (See Para. 0062) and would not pose a serious burden on the examiner if restriction is not required. By the same token, the species cited in the Markush group of claim 8 are generally encompassed in the term "fibrate" (See Para 0014) and would not pose a serious burden either on the examiner if restriction is not required.

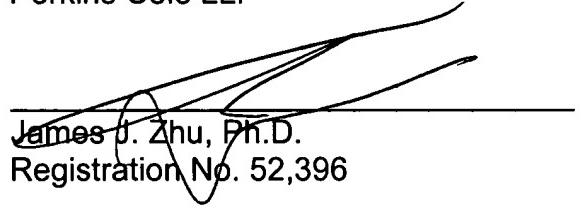
Further, in application where only generic claims are presented, restriction cannot be required unless the generic claims recite or encompass such a multiplicity of species that an unduly extensive and burdensome search would be necessary to search the entire scope of the claim. See MPEP § 808.01(a). With respect to the term "chemotherapeutics" in claim 10; only a generic claim is presented which does not recite a multiplicity of species.

In light of the foregoing, Applicant respectfully requests the restriction on species be reconsidered and withdrawn. However, to expedite the prosecution of the instant application, Applicant provisionally elects the following species: A) carcinomas as one species of neoplasm; B) gemfibrozil as one species of fibrate; and C) doxorubicin as one species of chemotherapeutics.

Applicant hereby requests a five-month extension of time in which to reply to said Office Action, extending the period for reply from October 22, 2006 to March 22, 2007. The Commissioner is hereby authorized to charge Deposit Account No. 50-2586 in the amount \$1,080.00 for the requisite fees. The Commissioner is authorized to charge any additional fees due or credit any overpayment to Deposit Account No. 50-2586.

Respectfully submitted,
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